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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,957	07/14/2003	Mitsushi Yamamoto	UNI79.013AUS	6418

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EXAMINER

AHMAD, NASSER

ART UNIT PAPER NUMBER

1772

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/618,957

Applicant(s)

YAMAMOTO ET AL.

Examiner

Nasser Ahmad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Indicated Allowability and Finality Withdrawn

1. Upon further consideration and a review of the claimed subject matter and in view of the newly uncovered art, the indicated Allowability of claim 8 and the Finality of the last Office Action is being withdrawn.

Prosecution is being reopened and a complete Office Action on the merit follows:

Rejections Withdrawn

2. Claims 1-2 and 7 rejected under 35 USC 103(a) as being unpatentable over Takei made in the last Office Action of July 8, 2005 has been withdrawn in view of the amendment filed on October 11, 2005.

3. Claims 4 and 6 rejected under 35 USC 103(a) as being unpatentable over Sugawara in view of Takei in the last Office Action has been withdrawn in view of the amendment.

4. Claims 3 and 5 rejected under 35 USC 103(a) as being unpatentable over Koyama in view of Takei in the last Office Action has been withdrawn in view of the amendment.

5. Claim 8 rejected under 35 USC 112, second paragraph has been withdrawn in view of the amendment.

Response to Arguments

6. Applicant's arguments with respect to claims 8 has been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8, the phrase "pyrrolidium ring" is found to be confusing because it appears to be a spelling error as a search of the phrase did not uncover any references. However, when the term is modified to "pyrrolidinium ring", many reference were uncovered. Applicant is requested to either correct the spelling in the claims, as well in the specification, or provide explanation as to why the provided spelling is correct and how does it differentiate from "Pyrrolidinium ring".

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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10. Claim 8 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/969236. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and the application'236 are directed to a surface protective structure comprising a base film, an adhesive layer provided on one surface of the film and an antistatic layer provided on the other surface of the film. However, application'236 fails to claim that the structure is transparent, and that the antistatic layer comprises a polymer having pyrrolidinium ring in the main chain. It would have been obvious to modify application'236 by providing pyrrolidinium ring containing polymer as the antistatic layer because it is disclosed in paragraph [0037], that the structure will exhibit transparency as all the materials are the same.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claim 8 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 11/090813. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the applications are directed to the structure comprising a base layer with adhesive on one surface and antistatic layer on the other surface thereof. However, the application'813 fails to teach that the antistatic is a pyrrolidinium ring containing polymer. It would have been obvious to one having

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ordinary skill in the art to modify application'813 by providing pyrrolidinium ring containing polymer as the antistatic layer as discussed in paragraph-[0043] and the structure will exhibit transparency as all the layer are the of the same amterial.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claim 8 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 11/073456. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the applications are directed to a surface protective film structure comprising a base layer with adhesive on one surface ans antistatic polymer containing pyrrolidinium ring on the other surface..

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claim 8 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 10/619516 in view of Takeda (5082730). Application'516 relates to a surface protective film structure as is being claimed. However, it fails to show that the base layer has antistatic layer on the surface opposite from the adhesive surface. Application'516 also teaches in paragraph-[0040], the presence of antistatic layer on the base layer but fails tot each that the antistatic layer is pyrrolidinium ring containing

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polymer. Takeda discloses antistatic layer provided on a polyester film base to provide the desired antistatic characteristics.

This is a provisional obviousness-type double patenting rejection.

ABSTRACT

14. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract should be provided in a single paragraph.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Nasser Ahmad
Primary Examiner
Art Unit 1772
10/19/05

N. Ahmad.
October 19, 2005.